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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,996	03/03/2004	Carmen Flosbach	FA1013 US DIV	4286
23906	7590	07/29/2005	EXAMINER	
E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 07/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/791,996

Applicant(s)

FLOSBACH ET AL.

Examiner

Elena Tsoy

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11, 12, 16 and 18-21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: PTO-892.

Advisory Action

1. Amendment filed on July 11, 2005 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record as set forth in the Final Office Action mailed on 4/8/2005.

Claim 17 has been cancelled. Claims 11, 12, 16, 18-21 are pending in the application.

Response to Arguments

2. Applicants' arguments filed July 11, 2005 have been fully considered but they are not persuasive.

(A) Applicants argue that Duecoffre teaches away from the present invention because Duecoffre's clear coat does not contain a polyester polyol (a) of present invention, but instead contains a hybrid binder comprising polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization.

The Examiner respectfully disagrees with this argument. First of all, Duecoffre clearly teaches all components of claimed invention including B) separately from A) (See column 1, lines 41-60). Secondly, Duecoffre's clear coat does contain 80 wt % -60 wt % or less of a polyester polyol (a) of present invention, **in addition** to a hybrid binder comprising e.g. **at least 20 wt % -40 wt %** polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization (See Abstract; column 1, lines 61-67; column 2, lines 23-36). Moreover, claims 11 and 12 do not recite negative limitation about a hybrid binder, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12.

(B) Applicants argue that Duecoffre is silent about calculated hydroxyl functionality for the polyester polyol being within 4.5-10.

Art Unit: 1762

In contrast to Applicants' argument, Duecoffre expressly teaches that B) preferably have number average molecular weights of 200 to 5000, most preferably 1000 to 3000, an OH number of 30 to 450 mg KOH/g, most preferably from 120 to 280 mg KOH/g, and an acid number of 0 to 60 mg KOH/g, most preferably from 2 to 35 mg KOH/g (See column 5, lines 55-60).

(C) Applicants believe that Duecoffre teaches away from the claimed quantitative composition of components (a1) and (a2) of the present invention, which require that the hydroxyl components and carboxyl components comprise no more than 20 wt-o/o of at least one diol and at least one monocarboxylic acid, respectively. To the contrary, Example 1 of Duecoffre comprises 57.8 M % of monocarboxylic acid (isononanoic acid) among the carboxyl components and Example 2 of Duecoffre comprises 57 wt-% diol (hexane diol) among the hydroxyl components. In these Examples, both values (the 57.8 M-% and 57 wt-%) are far above the upper limit disclosed in the present invention, which is 20 wt-% in either case. This upper limit is set at 20 M-% to ensure the high level of hydroxyl-functionality of the final polyester of the present invention.

However, Duecoffre does teach that 0 to 40 wt % of diols, and 0 to 60% wt % of monocarboxylic acids (which cover claimed ranges) are used for preparing polyester polyols (See column 14, lines 40-65). Moreover, it is held that PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123.

(D) Applicants argue that the Examiner has not established a prima facie case of obviousness because the combination of Miyabayashi and Willey fails to teach the present invention. Applicants do not believe that one of ordinary skill in the art at would have reasonable expectation of success of combining Willey with Miyabayashi. The present invention utilizes a

Art Unit: 1762

color-imparting and/or special effect-imparting base coat while Willey is directed to a primer composition and such compositions are not generally interchangeable.

The Examiner respectfully disagrees with this argument. Miyabayashi et al disclose that a clear coating composition (See column 6, lines 25-26) can be applied to a steel, aluminum substrate (See column 6, lines 55-57) *pre-coated* with a primer (See column 6, lines 60-62) such as polyester primer (See column 7, lines 3-4).

Willey teaches that high solids colored polyester primer (claimed color-imparting base coat) can be primarily used in the manufacture of automobiles (See column 1, lines 7-8) for coating steel, aluminum substrates (See column 1, lines 48-58) to cover imperfections in surfaces (See column 1, lines 59-62) and provides the surface to which conventional topcoats will adhere (See column 1, lines 57-58).

Therefore, one of ordinary skill in the art at would have motivation and reasonable expectation of success of using colored polyester primer as a polyester primer for *pre-coating* steel, or aluminum substrate in Miyabayashi before applying a clear coating composition since Willey teaches that high solids colored polyester primer (claimed color-imparting base coat) can be primarily used in the manufacture of automobiles for coating steel, aluminum substrates (See column 1, lines 48-58) to cover imperfections in surfaces (See column 1, lines 59-62) and provides the surface to which conventional topcoats will adhere.

Thus, the prima facie case of obviousness has not been rebutted.

(C) Applicants argue that the term “primer” and “base-coat” refer to two different entities, as evidenced by references cited by the Applicants.

The Examiner respectfully disagrees with this argument. It is well known in the art that “base-coat” can be used as “primer” or “primer” can be used as “base-coat”, e.g. a colored *primer-*

Art Unit: 1762

base coat, as evidenced by Panush et al (US 4,615,940, See column 12, line 47), or pigmented *basecoat primer*, as evidenced by Crast et al (US 6,018,012, See column 1, line 21).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-141523. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
E Tsoy

July 27, 2005